

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAMMY L. MAVER

Appeal No. 1997-1748
Application No. 08/394,935

ON BRIEF

Before JOHN D. SMITH, GARRIS, and KRATZ, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-4, 6, 7 and 12-14. Claims 10 and 11, the remaining claims pending in this application, stand withdrawn from further consideration as drawn to a non-elected invention.

BACKGROUND

At the outset, we note that Patent and Trademark Office (PTO) records indicate that the present application was filed as a continuation of U.S. Application No. 08/167,385, which parent application was filed on December 15, 1993. Also, copending and related application No. 08/395,248 was filed on February 27, 1995, as a divisional of the above-noted parent application. The above-noted related and copending Application No. 08/395,248 is also before us on appeal (Appeal No. 1997-1807).

Appellant's invention relates to a blended polymeric composition comprising a macromolecular aqueous dispersion, an acid-functional alkali soluble resin and an aminosilane compound. According to appellant (specification, page 4), the composition is useful as a coating for chalky substrates. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

A blend composition for improving the adhesion of a coating to chalky substrates comprising a macromolecular aqueous dispersion having a particle size in the range of 0.05

to 1.0 micron, an acid-functional alkalisoluble polymer polymerized from monomers selected from the group consisting of olefinically unsaturated compounds, vinyl esters and monovinyl aromatic compounds, said polymer having a weight average molecular weight of less than about 100,000 to ensure its solubility and having its acid functionality neutralized by an aminosilane selected from the group consisting of trimethoxysilylpropyldiethylenetriamine, N-methylaminopropyltrimethoxysilane, N-(2-aminoethyl)-3-aminopropylmethyldimethoxysilane, N-(2-aminoethyl)-3-aminopropyltrimethoxysilane, aminopropylmethyldimethoxysilane, 3-aminopropyltrimethoxysilane, 3-aminopropylmethyldiethoxysilane and 3-aminopropyltriethoxysilane.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Calhoun	WO 92/14788	Sep. 03, 1992
(Published International Application)		

Morino et al. (Morino) ¹	03-064305	Mar. 19, 1991
(Laid-open Japanese Patent Application)		

Claims 1-4, 6, 7 and 12-14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Calhoun in view of Morino.

OPINION

Upon review of the opposing arguments and evidence advanced by the examiner in the answer and appellant in the

¹ Our reference to Morino in this decision is to the resubmitted English translation of record filed on January 11, 1996.

brief in support of their respective positions, we conclude that the examiner has not established a *prima facie* case of obviousness for the claimed subject matter.² Accordingly, we will not sustain the examiner's § 103 rejection for reasons set forth in appellant's brief and as further discussed below.

Calhoun (page 1) teaches that a blended polymeric composition containing at least one acid-functional vinyl polymer and at least one amino-functional siloxane polymer may be used as a quasi-crosslinked coating for various substrates. Calhoun (pages 3-5) further teaches that: (1) the amino-functional polysiloxane employed is water-insoluble albeit the blended polymer composition is soluble or dispersible in water and (2) an alkali or basic ingredient such as a volatile amine or ammonia is included in the composition to prevent reaction of the siloxane with the acid-functional moieties of the vinyl polymer.

Morino (pages 1 and 2) discloses a silane-modified macromolecular dispersion for use in a coating material that is taught as advantageous for its adherence to silicate glass. The silane is described as water-soluble

² We note that it is the examiner who bears the initial burden of presenting a *prima facie* case of obviousness in rejecting claims under 35 U.S.C. § 103. See *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

(Morino, page 6).

According to the examiner (answer, page 3),

[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to use the aminosilanes of JP '305 in WO '788 and expect them to function equivalently for the neutralization of an acid functional polymer in order to make the claimed blend composition for improving adhesion to chalky substrates especially since no criticality of components is noted.

The difficulty we have with the examiner's stated position stems, in part, from the fact that the examiner has not pointed to any particularized teaching of either of the applied references which would have suggested that the addition of the silane of Morino (JP '305) to the blend of Calhoun (WO '788) would function to improve adherence to chalky substrates as posited by the examiner as a basis for adding or substituting the silane of Morino for one or more of the ingredients of the composition of Calhoun. Nor has the examiner furnished any other convincing rationale for the proposed modification of the composition of Calhoun including a detailed explanation as to how any such proposed modification would have resulted in a blend composition corresponding to appellant's specified blend.

In order for a *prima facie* case of obviousness of the

claimed invention to be established, the prior art as applied must be such that it would have provided one of ordinary skill in the art with both a suggestion to carry out appellant's claimed invention and a reasonable expectation of success in doing so. *See In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). "Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *Id.* The mere possibility that the prior art could be modified such that appellant's invention would result, is not a sufficient basis for a *prima facie* case of obviousness. *See In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996); *In re Ochiai*, 71 F.3d 1565, 1570, 37 USPQ2d 1127, 1131 (Fed. Cir. 1995).

From our perspective, the examiner has not convincingly explained where the motivation may be found in the combined teachings of the references to support the alleged "functional equivalency" as a basis for modifying the composition of Calhoun. This motivation appears to come solely from the description of appellant's invention in their specification. Thus, on this record, we conclude that the examiner used

impermissible hindsight when rejecting the claims in the manner set forth in the answer. See *W.L. Gore & Associates v. Garlock, Inc.*,

721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960). Accordingly, on this record, we will not sustain the examiner's stated rejection.

CONCLUSION

To summarize, the decision of the examiner to reject the appealed claims under 35 U.S.C. § 103 as stated in the answer

is reversed.

REVERSED

JOHN D. SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
BRADLEY R. GARRIS)	APPEALS
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)	INTERFERENCES
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DECISION: **ED**

Prepared By:

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FINAL TYPED: